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EXAMINER

DUONG, THOMAS

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKEO KATSUDA

Appeal 2009-011070
Application 09/880,039
Technology Center 2400

Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and
MARC S. HOFF, Administrative *Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the rejection of claims 14, 31, 38, 40, 42, and 44 through 46. The Examiner has indicated that claims 15 through 30, 37, 39, 41, 43, and 47 contain allowable subject matter.¹

We Affirm-in-part.

INVENTION

The invention is directed to an e-mail controlling apparatus which allows a user of a personal computing device upon receiving an e-mail to have attachments to the e-mail sent to other devices. *See* paragraphs 7 through 10 of Appellant's Specification. Claim 14 is representative of the invention and is reproduced below:

14. An E-mail controlling apparatus comprising:

an E-mail receiving device receiving E-mail including a main text portion and an attachment file portion and being addressed to a portable terminal unit;

an E-mail preparing device preparing receipt notice E-mail by removing the attachment file portion from the received E-mail;

an E-mail transmitting device transmitting to said portable terminal unit the receipt notice E-mail prepared by said E-mail preparing device and an E-mail identifying multiple prospective image output devices;

an instruction receiving device receiving an E-mail including an instruction for specifying one of multiple image output devices;

a converting device converting the attachment file portion into data of a format acceptable to the image output device; and

a data transmitting device transmitting said data after the conversion to the image output device specified by said instruction.

¹ *See* Non-Final Office action dated March 21, 2008.

REFERENCES

Theimer	5,493,692	Feb. 20, 1996
Miller	6,421,707 B1	Jul. 16, 2002

REJECTIONS AT ISSUE

The Examiner has rejected claims 14 and 31 under 35 U.S.C. § 102(e) as being anticipated by Miller. The Examiner's rejection is on pages 3 through 6 of the Answer.²

The Examiner has rejected claims 38, 40, 42, and 44 through 46 under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Theimer. The Examiner's rejection is on pages 6 through 10 of the Answer.

ISSUE

Anticipation Rejection of claims 14 and 31

Appellant argues on page 7 of the Brief and pages 1 and 2 of the Reply Brief³, that the Examiner's rejection of independent claims 14 and 31 is in error. Appellant's arguments present us with the issue: did the Examiner err in finding that Miller teaches transmitting to the portable unit a receipt e-mail which includes an identification of multiple prospective image output devices as claimed?

² Throughout this decision we refer to the Examiner's Answer dated December 24, 2008.

³ Throughout this decision we refer to the Brief dated September 23, 2008, and the Reply Brief dated February 23, 2009.

Obviousness rejection of claims 38, 40, and 42

Appellant argues the obviousness rejection of claims 38, 40, and 42 on pages 8 and 9 of the Brief and pages 2 and 3 of the Reply Brief. Appellant's arguments present us with the issue: did the Examiner err in finding that Miller teaches an e-mail notification is sent to the destination of an incoming e-mail and that the notification identifies an image output device to which the a portion of the original e-mail is sent?

Obviousness rejection of claims 44 through 46

Appellant argues the obviousness rejection of claims 44 through 46 on pages 10 and 11 of the Brief and pages 3 and 4 of the Reply Brief. Appellant's arguments present us with the issue: did the Examiner err in finding that Miller teaches generating an e-mail containing notification or receipt of an e-mail and notification of at least one output device to which part of the e-mail is output as claimed?

ANALYSIS

Anticipation Rejection of claims 14 and 31

We have reviewed Appellant's arguments in the Briefs and we concur with Appellant's conclusion that the Examiner erred in finding that Miller teaches transmitting to the portable unit a receipt e-mail which includes an identification of multiple prospective image output devices as claimed. The Examiner identifies that Miller's figures 4(j), 4(n), 4(q) and 4(t) show that Miller teaches mail forwarding to different devices. Answer 10-11. We concur. However, the Examiner has not shown that the information the hand held computer displays shown in these figures is from an e-mail as claimed.

Further, we note that claims 14 and 31 recite an instruction receiving device that receives an e-mail specifying the image output device and that the data is transmitted to the output device. Thus, the data indicating the image output devices is functionally related to the apparatus claimed. Accordingly, we will not sustain the Examiner's anticipation rejection of claims 14 and 31.

Obviousness rejection of claims 38, 40, and 42

We have reviewed Appellant's arguments in the Briefs and we concur with Appellant's conclusion that the Examiner erred in finding that Miller teaches an e-mail notification is sent to the destination of an incoming e-mail and that the notification identifies an image output device to which a portion of the original e-mail is sent. The Examiner responds to this argument by finding that lines 33 through 38 in column 3 of Miller teach that the delivery subsystem teaches sending a notification that a message has been received. Answer 12. We concur; however, the Examiner has not shown that this notification contains the notification of the selected image output device as recited in claims 38, 40, and 42. We note that the selected output device is selected based upon an acquired location information of the destination, thus the information is the product of a claimed function. The Examiner has not shown that the teachings of Theimer make up for this deficiency. Accordingly, we will not sustain the Examiner's obviousness rejection of claims 38, 40, and 42.

Obviousness rejection of claims 44 through 46

We have reviewed Appellant's arguments in the Briefs and we disagree with Appellant's conclusion that the Examiner erred in finding that Miller teaches generating an e-mail containing notification or receipt of an e-mail and notification of at least one output device to which part of the e-mail is output as claimed. Claim 44 recites a processor that generates an e-mail containing notification or receipt and information on at least one output device. However, claim 44 recites no function associated with this information other than it is sent to a certain destination. Thus, the content of the generated e-mail is not functionally related to the claimed apparatus. The Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004) and our decision in *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative), *aff'd*, No. 06-1003 (Fed. Cir. Jun. 12, 2006) (Rule 36). As such, even if the information in the receipt notification sent to the user of Miller's system (Appellant admits such a receipt notification on page 9 of the Brief) is different from that which is claimed, such a difference will not differentiate the claim from the prior art. Accordingly, Appellant has not persuaded us of error in the Examiner's rejection of claims 44 through 46 and we sustain the Examiner's rejection.

CONCLUSION

Appellant has persuaded us of error in the Examiner's decision to reject claims 14, 31, 38, 40, and 42. Appellant's arguments have not

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persuaded us of error in the Examiner's decision to reject claims 44 through 46.

DECISION

The decision of the Examiner to reject claims 14, 31, 38, 40, 42, and 44 through 46 is affirmed in part.

AFFIRMED IN PART

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